

REMARKS

Favorable reconsideration is respectfully requested.

The claims are 9-12.

The above amendment is responsive to points set forth in the Official Action.

With regard to new claim 12, support is evident from page 5, lines 1-7 of the present specification.

Turning to Official Action paragraph 3, claim 10 has been rejected as indefinite in the term "applied to such an extent as not to exceed". In reply, the term in issue has been replaced by the term "which does not exceed". The new terminology does not relate to process terminology and is perfectly clear to one of ordinary skill in the art.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suenaga et al. (US 6,133,170) in view of Kondo et al. (US 6,000,794).

Further, claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/00541 in view of Kondo et al.

These rejections are respectfully traversed.

Firstly, in view of the above amendment, the paper of the present invention is considered to be made of mercerized pulp only or a mixture of mercerized pulp and paper making pulp, and is thus distinguished from paper including curled fiber (Kondo et al.) or paper overlayed or nonwoven web and impregnated with latex (WO 99/00541).

Further, in both of the above rejections on prior art, it is stated that

The determination of the liquid transfer length by Bristow's method is according to J. Tappi No. 51-87 is a product by process limitation.

In this regard, the rejection maintains that the patentability of a product does not depend on its method of production and if the product in a product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable even though the prior art product was made by a different process.

In reply, the rejection improperly characterizes the liquid transfer length as a product-by-process limitation since, in fact, it is a parameter defining the properties of the claimed inkjet recording paper and has nothing to do with the process for making the paper. D13

Moreover, in support of the difference between the presently claimed and reference papers, there is submitted herewith the Rule 132 Declaration of Y. Tomotake, the first named Inventor herein.

This Declaration compares a representative sample of the paper in accordance with the present invention with representative samples from Suenaga et al. and WO 99/00541 i.e. the primary references of the rejections.

The liquid transfer length values of each of the samples and comparative samples are set forth on page 5 of the Declaration.

As is evident from the discussion on pages 6 and 7 of the Declaration, the samples in accordance with the present invention and prior art all employ substantially similar amounts of mercerized pulp. However, the use of curled fibers as in Suenaga et al. produces low density paper unsuitable for inkjet recording and in the case of the papers impregnated with latex as in WO 99/00541, the resultant paper is inhibited in ink absorption and non-uniformity in color may occur.

The differences between the present invention and the prior art are thus clear and the results of the present invention are vividly and unobviously distinguished from those of the prior art.

For the foregoing reasons, withdrawal of the rejections on prior art is respectfully requested.

If the Examiner is of the opinion that the foregoing amendments, remarks and showing fail to overcome the rejections, he is respectfully requested to contact undersigned at the telephone number below before issuing a further Official Action in order that any outstanding issues may be resolved in the course of an Interview.

Respectfully submitted,

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9. (Amended) An ink jet recording paper having a high ink coloring density and a high ink absorption speed, said paper comprising from 10 to 100% by weight of mercerized pulp based on an entire fiber material and 90 to 0% by weight of paper making pulp, having a liquid transfer length in Bristow's method according to J. Tappi No. 51-87 of 100mm or less, when distilled water has been set at $50\mu\text{L}$ in a head box of 1mm slit width and 15mm slit length and the moving speed of a test specimen has been set to 5.0mm/sec.

10. (Amended) The ink jet recording paper according to claim 9 wherein said paper has a coating which does [applied to such an extent as] not [to] exceed the liquid transfer length in Bristow's method of 100mm.